REMARKS

By this Amendment, Applicants amend claim 3. With claims 1, 2, and 4-6 having been previously canceled, claims 3, 7, and 8 remain pending.

In the final Office Action of May 7, 2004[1] ("OA"), claim 7 was rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,584,054 to *Tyneski et al.* ("*Tyneski*"); claim 3 was rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,797,089 to *Nguyen* ("*Nguyen*") in view of U.S. Patent No. 6,233,464 to *Chmaytelli* ("*Chmaytelli*"); and claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Nguyen* in view of *Tyneski*. Applicants address the rejections below.

Rejection of claim 7 under 35 U.S.C. § 102(b)

Applicants traverse the rejection of claim 7 under 35 U.S.C. § 102(b) because *Tyneski* fails to anticipate this claim. In order to anticipate Applicants' claim 7, each and every element of the claim must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim[s]." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th Ed. 2001), p. 2100-69.

Tyneski does not teach or suggest each and every claimed feature of claim 7. *Tyneski* describes a portable communication device having "first and second modes of operation controlled by a moveable flap" (col. 1, lines 5-7; Abstract). According to *Tyneski*, the first mode

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

"provides two way voice communication" and the second mode "provides a personal organizer" (Abstract). As the Examiner notes (OA at 2), *Tyneski* mentions that "[w]hile the handset 100 is operating as a personal organizer . . ., signaling information can still be received with the antenna 110, and . . . [t]he user may then close the flap 104 and use the handset as a cordless telephone" (col. 2, lines 50-55).

In contrast, claim 7 recites a radio communication apparatus comprising "means for enabling the first mode [in which the apparatus emits radio waves] when the apparatus is switched on, and for enabling the second mode [in which the apparatus does not emit radio waves] when the receiving means thereafter receives a predetermined instruction." *Tyneski* does not teach or suggest the above features. Contrary to the Examiner's position, *Tyneski*'s second mode of operation is not consistent with the claimed "second mode," in which the apparatus does not emit radio waves. Although *Tyneski* mentions a second mode of operation that provides a personal organizer, the reference fails to disclose that radio waves are not emitted in this second mode. While *Tyneski* mentions, as the Examiner notes, sending a signal to a "controller . . . to indicate that the handset is to switch over to function as personal organizer," the reference does not teach or suggest that the controller (or any other element) prevents the device from emitting radio waves (e.g., for synchronization purposes) while operating as a personal organizer. Indeed, the Examiner provides no evidence to support the allegation that radio waves are not transmitted from *Tyneski*'s communication device while it operates in the second mode of operation. For at least these reasons, *Tyneski* fails to teach at least "means for enabling the first mode [in which the apparatus emits radio waves] when the apparatus is switched on, and for enabling the second mode [in which the apparatus does not emit radio waves] when the receiving means thereafter receives a predetermined instruction," as claimed.

Because *Tyneski* does not teach each and every feature of independent claim 7, as a matter of law, it cannot anticipate this claim. Applicants thus request withdrawal of the rejection of claim 7 under 35 U.S.C. § 102(b) and the timely allowance of this pending claim.

Rejection of claim 3 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 3 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established based on *Nguyen* and *Chmaytelli*. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

A *prima facie* case of obviousness has not been established because, among other things, neither *Nguyen* nor *Chmaytelli*, nor any combination thereof, teaches or suggests each and every feature of Applicants' claims.

Independent claim 3, as currently proposed, recites a combination including:

> means for enabling the processing means and the radio signal receiving means when the apparatus is switched on, and for enabling the transmitting means when the instruction receiving means thereafter receives a predetermined instruction.

Nguyen fails to teach or suggest at least the above-noted subject matter. In fact, the Examiner appears to concede that *Nguyen* fails to teach "means for enabling the processing means and enabling the [transmitting] means" (OA at 4).

Chmaytelli does not cure the deficiencies of *Nguyen*. *Chmaytelli* is directed to a "combined . . . PDA . . . and wireless telephone" (Abstract). *Chmaytelli* discloses a switch that powers on and off the wireless telephone and the PDA (col. 2, lines 6-33). According to *Chmaytelli*, the switch is responsive to an "action trigger (202) which sends a signal to the switch (204) when . . . [a] stylus (102) is removed from [and replaced into] the stylus holder" (col. 2, lines 6-10). *Chmaytelli* does not teach or suggest "means for enabling the processing means and the radio signal receiving means when the apparatus is switched on, and for enabling the transmitting means when the instruction receiving means thereafter receives a predetermined instruction," as claimed. Turning a PDA and wireless telephone on and off in response to the removal and replacement of a stylus, as described by *Chmaytelli*, does not teach or suggest enabling the processing means and the radio signal receiving means when the apparatus is switched on and then enabling the transmitting means when a predetermined instruction is received, as claimed. *Chmaytelli*'s switch does not enable processing means and receiving means when the apparatus is switched on and then enable transmitting means when a predetermined instruction is received.

Nguyen and *Chmaytelli* therefore fail, alone and in combination, to teach or suggest each and every feature of claim 3. For at least this reason, a *prima facie* case of obviousness has not been established with respect to claim 3.

Moreover, the Examiner has not established a *prima facie* case of obviousness since there is no motivation to combine the references. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by "substantial evidence"). The desire to combine

references must be proved with "substantial evidence" that is a result of a "thorough and searching" factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action provides no "substantial evidence" to support the attempted combination of *Nguyen* and *Chmaytelli*. The Examiner alleges that a skilled artisan would have combined the reference "in order to obtain coordination between the PDA and the Telephone . . . to prevent loss [of] calls or data . . . when the PDA or the Telephone is improperly turned off" (OA at 4). These conclusory statements in the Office Action are not properly supported by facts on the record and do not evidence that a skilled artisan would have been motivated to combine the references. While *Chmaytelli* mentions that :[i]t is important that the power on/off of the telephone be coordinated with the power on/off of the PDA" (col. 1, lines 33-35), the Examiner has not shown, by substantial evidence, that a skilled artisan considering the cited references, and not having the benefit of Applicants' disclosure, would have been motivated to combine the references in a manner resulting in Applicants' claimed combination.

Applicants call attention to M.P.E.P. § 2143.01, which makes clear that the "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As explained above, the Examiner does not show that the cited art "suggests the desirability" of the combination. No objective reason for combining the applied art, other than the Examiner's attempt to meet the terms of claim 3, has been established. One of ordinary skill in the art would have appreciated, at the time of the invention, that *Nguyen* and *Chmaytelli* do not suggest the Examiner's proposed combination, absent the benefit of Applicants' disclosure.

M.P.E.P. § 2143 instructs that the requirements for establishing *prima facie* obviousness must "be found in the prior art, and not be based on applicant's disclosure." Further, M.P.E.P. § 2142 articulates:

> Knowledge of applicant's disclosure must be put aside.... [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants' claims were improperly used to reconstruct the prior art. A skilled artisan would not have been motivated, without consulting Applicants' disclosure, to combine the teachings of *Nguyen* and *Chmaytelli*. Neither of these references teaches or suggests combining their respective teachings as alleged in the Office Action. The conclusions in the Office Action, therefore, constitute improper hindsight reasoning.

Because the required motivation to combine the applied references is lacking, and since the applied references (even if combined) fail to teach or suggest each and every claim recitation, *prima facie* obviousness has not been established with respect to claim 3. Applicants thus request withdrawal of the rejection of claim 3 under 35 U.S.C. § 103(a) and the timely allowance of this pending claim.

Rejection of claim 8 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 8 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established based on *Nguyen* and *Tyneski*.

Claim 8 recites a combination including:

> means for prohibiting the radio signal transmission by the transmitting means in accordance with the instruction, while keeping the processing means and the radio signal receiving means operable.

As affirmed by the Examiner (OA at 4), *Nguyen* does not teach or suggest the above-noted features. *Tyneski*, moreover, does not cure *Nguyen*'s deficiencies. Although *Tyneski* mentions a communication device that can operate in a "two way voice communication" mode and a "personal organizer" mode, the reference does not disclose or suggest "means for prohibiting the radio signal transmission by the transmitting means in accordance with the instruction, while keeping the processing means and the radio signal receiving means operable," as recited in claim 8. As explained above, *Tyneski* fails to disclose that radio waves are not emitted in the "personal organizer" mode of operation.

Nguyen and *Tyneski*, therefore fail, alone and in combination, to teach or suggest each and every feature of claim 8. For at least this reason, a *prima facie* case of obviousness has not been established.

Furthermore, the requisite motivation for combining *Nguyen* and *Tyneski* is lacking. The Examiner has not shown in the Office Action, by substantial evidence, that a skilled artisan considering the cited references, and not having the benefit of Applicants' disclosure, would have been motivated to combine the references in a manner resulting in Applicants' claimed combination. The Examiner merely provides a description of how *Tyneski* allegedly teaches certain features not found in *Nguyen* without a proper motive for combining these references. In particular, the Examiner alleges that a skilled artisan would have combined the references "to avoid having to carry separate devices for cordless phone and personal organizer . . ." (OA at 5). This statement in the Office Action does not evidence that a skilled artisan would have been motivated to combine the references. Further, a skilled artisan considering *Nguyen* would not have been concerned with addressing the supposed cumbersomeness of carry separate devices because *Nguyen*'s communication terminal includes both a mobile telephone unit and a PDA unit

(Abstract). A skilled artisan would, therefore, not have been motivated to combine the references for the reason alleged by the Examiner. Again, Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants' claims were improperly used to reconstruct the prior art.

Because the required motivation to combine the applied references is lacking, and since the applied references (even if combined) fail to teach or suggest each and every claim feature, *prima facie* obviousness has not been established with respect to claim 8. Applicants thus request withdrawal of the rejection of claim 8 under 35 U.S.C. § 103(a) and the timely allowance of this claim.

Conclusion

Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 8, 2004

By: _____
Frank A. Italiano
Reg. No. 53,056